

Attorney Docket # 4925-84

Serial No. 09/800,772

REMARKS

Claims 1-44 are pending, with Claims 1, 12, 19, and 24 being the only independent claims. In the final Office Action dated 16 January 2003, the Examiner rejected Claims 1-28 under 35 U.S.C. §103(a) over *Darling* (WO 93/231,125) in view of *Jamtgaard et al.* (US 6,430,624). It is assumed that the Examiner intended to reject all pending claims (1-44) based on the same grounds. Reconsideration and withdrawal of the final rejection are requested on the basis of the following remarks.

Applicant believes that the Examiner has failed to establish a *prima facie* case of obviousness under §103(a).

One of the essential criteria that must be met to establish a *prima facie* case of obviousness is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. However, in the present instance, there is no suggestion or motivation to combine *Darling* and *Jamtgaard et al.*

Jamtgaard et al. discloses (in the Abstract):

A content delivery system and method are provided in which different types of content may be delivered to different information appliances having different protocols and different browser specifications. The system permits internet content providers to create a single piece of content that is re-formatted automatically for the different information appliances.

The content delivery system and method in accordance with the invention solves the above problems and limitations with conventional systems and solutions by providing a system and method that delivers Web-based content, commerce, enabling transactions, and services to a variety of information appliances

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and devices without requiring the re-authoring of the content information for display on each of these different devices.

In accordance with the invention, the system and method permits content to be input into the system in a variety of different formatting languages. In addition, the system permits the formatted content to be output in any mark-up language and protocol, such as WML, HTML, HDML, XML, etc. Advantageously, each display page on the device may be customized. To organize the content for display on the devices, the received content information may be mapped into a hierarchy of groups so that the content information can be optimally formatted for display on the devices according to the input/output format, such as the display screen size parameters of the devices.

In more detail, the method for content delivery may include intelligently harvesting content from a web page to provide that content to a plurality of different information appliances having different screen sizes. The intelligent harvesting may convert the content into a proprietary relational markup language (RML) and generate a tree and then a document object model from the RML content. The tree may then be analyzed and searched using a set of processing rules in order to generate content screens customized to each information appliance. A typical card builder may build the card corresponding to the customized content and a typical deck builder may build a deck of cards corresponding to the one or more display screens that make up the content for the particular information appliance. The deck of cards may then be converted into a presentation format and protocol for the particular information appliance and sent to that information appliance.

(emphasis added, Column 2, line 40 – column 3, line 9)

Jamtgaard et al. teaches a web-based content delivery system, wherein the content may be stored as a single file that can be re-formatted automatically for use by various client appliances having different capabilities. The re-formatting is performed by a dedicated translation server (12 in FIG. 2), which takes information directly from an Internet content provider's web-site in various forms, and then re-delivers it through telecommunications system to WAP compliant client devices (col. 4, line 58 – col. 5, line 6).

By contrast, *Darling* teaches a multi-player gaming system, wherein game data is communicated directly between the gaming devices. Each gaming device runs the game

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program independently and performs operations according to the game instructions. *Jamtgaard et al.* does not teach anything relating to gaming or multiplayer gaming, or to person-to-person messaging. *Jamtgaard et al.* teaches a centralized web-based client-server type content delivery system, wherein the central server includes a translation server for re-formatting data according to client terminal capabilities.

Applicant believes there is no suggestion or motivation to combine the teachings of *Darling* and *Jamtgaard et al.* Whether it is possible to combine the two references is irrelevant ("The mere fact that two references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination", MPEP §2143.01, citing *In Re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Thus, although *Darling* discloses that interactive gaming data may be communicated between hand-held game machines manufactured by different companies, there is no motivation or suggestion to merge the direct person-to-person (terminal-to-terminal) game messaging system disclosed in *Darling* with the web-centric content delivery (server/client) teachings of *Jamtgaard et al.* in order to provide a multi-player gaming system including predefined messaging, wherein the predefined messaging takes into consideration the terminal capabilities of the gaming terminal receiving the predefined messages.

In fact, the only suggestion one could have to combine these two teachings is contained in the disclosure of the present application, and using knowledge of the applicant's disclosure in order to combine references is "impermissible hindsight" and must be avoided (MPEP §2142).

In conclusion, since there is neither a suggestion nor a motivation for combining *Darling* and *Jamtgaard et al.*, and such a suggestion or motivation is an essential criteria for a

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prima facie case of obviousness, the Examiner has not made a *prima facie* case of obviousness under §103(a). Withdrawal of the rejection is respectfully requested.

Respectfully submitted,

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